

REMARKS

Remark 1:

Applicant reminds Examiner of the March 16, 2006 Examiner's Telephonic Interview. During that interview, Examiner suggested specific changes to the amended claims mailed by Applicant on February 24, 2006, in an Amendment and Response to Paper Mailed 12/05/2005. The amendments presented herein incorporate the suggestions made by Examiner in regards to Claims 1 and 2. Examiner stated that Claims 3 and 6, as presented in Applicant's paper mailed February 24, 2006, would be allowable.

Furthermore, Applicant removed the term "swimming" since the invention can be applied to or be used with essentially any type of "pool" in which a modular lid system is used for an underwater compartment.

Remark 2:

Examiner affirmed his rejection of Claims 4 and 5 during subsequent telephone message dated March 20, 2006. Applicant observes that in affirming his final rejections of previously presented claims 4 and 5, the Examiner may not have understood that a reference must contain, show or describe each of the elements recited in a patent application claim for it to anticipate the claimed invention under 35 USC § 102(a) & (e).

An integral torsion member is not shown in the reference cited. Nor are buoyancy tanks described in the prior art. The buoyancy tanks, a functional feature of the invented hinged lid system, in combination with the torsion bar member, mitigate torsional twisting of the lid, thereby balancing gravitational and buoyancy forces.

In particular, for anticipation under 35 U.S.C. 102, each and every limitation expressed in a claim must be found, either expressly or inherently, in a single prior art reference *Celeritas Techs. Ltd. v. Rockwell Int'l Corp.*, 150 F.3d 1354, 1361 (Fed. Cir. 1998) [See also *IN RE CRISH*, 393 F.3d 1253, 1256 (Fed. Cir. 2004) *Glaxo Inc. v. Novopharm Ltd.*, C.A.Fed. (N.C.) 1995, 52 F.3d 1043, 34 U.S.P.Q.2d 1565, rehearing denied, in banc suggestion declined, certiorari denied 116 S.Ct. 516.

Anticipation of invention occurs only when some single prior article, patent, or publication contains within its four corners every element of a claim in question; patentability is not anticipated when its elements are distributed among several prior publications or devices. *Paeco, Inc. v. Applied Moldings, Inc.*, C.A.3 (Pa.) 1977, 562 F.2d 870, 194 U.S.P.Q. 353.

Even though an Examiner is entitled to give claims presented their broadest reasonable interpretation [*IN RE CRISH*, *ibid*], an element/step positively recited in the claim(s) cannot be disregarded. As observed by Chief Judge Markey in *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed.Cir. 1983):

"The (district court) opinion says anticipation may be shown by less than "complete anticipation" if one of ordinary skill may in reliance on the prior art "complete the work required for the invention", and that "it is sufficient for an anticipation 'if the general aspects are the same and the differences in minor matters is only such as would suggest itself to one of ordinary skill in the art.'" Those statements relate to obviousness, not anticipation. Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim. *Soundsciber Corp. v. U.S.*, 360 F.2D 954, 960, 148 USPQ 298, 301 (Ct.Cl. 1966). A prior art disclosure that "almost" meets that standard may render the claim invalid under § 103; it does not "anticipate." Though it is never necessary to so hold, a disclosure that anticipates under § 102 also renders the claim invalid under § 103, for "anticipation is the epitome of obviousness," *In re Fracalossi*, 681 F.2D 792, 215 USPQ 569 (CCPA 1982). The reverse is not true, for the need to determine obviousness presumes anticipation is lacking." 722 F.2d at 1548, 220 USPQ at 198.

[See also *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2D707, 715-16,

23 USPQ 1264, 1270 (Fed. Cir. 1984).

Indeed, 35 U.S.C. § 103(a) provides:

(a) A patent may not be obtained *though the invention is not identically disclosed or described as set forth in section 102 of this title*, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made. (emphasis added)

In citing U.S. Patent No. 6,536,175 to Conterno as anticipating subject matter of recited Applicant's claims 4-5 as amended in his Amendment and Response To Office Action Mailed 05/06/2005 under 35 U.S.C. § 102(a) & (e), the Examiner has assumed, like the district courts in *Connell v. Sears, Roebuck & Co.*, (supra) and *Structural Rubber Prods. Co. v. Park Rubber Co.*, (supra), in the words of Chief Judge Markey, that "it is sufficient for an anticipation if the general aspects are the same and the differences in minor matters is only such as would suggest itself to one of ordinary skill in the art."

Examiner cannot assume without citing a prior art reference teaching that panel and jointing assembly systems of *Conterno* can function as a modular lid for an underwater pool enclosure.

The described and illustrated *Conterno* panel and jointing structure does not have a lid section for an underwater enclosure. *Conterno* does not have a hinge for coupling a lid section to an underwater enclosure. *Conterno* does not have a torsion structural member disposed adjacent the inner surface and adjacent the hinged pivoting edge. *Conterno* does not have coupling means located on a side edge for coupling the lid section to one or more additional lid sections, whereby the coupled lid sections form a rigid, longitudinal modular lid that can be opened and closed as a unit. Finally, *Conterno* does not have

any suggestion or reference at all to buoyancy tanks disposed within the modular lid sections.

The *Conterno* reference does not, by itself, without the benefit of impermissible assumptions, ***disclose or describe, expressly or inherently:***

- (1) a lid section for an underwater enclosure; nor
- (2) a hinge for coupling the lid section to the underwater enclosure; nor
- (3) a torsion structural member disposed adjacent the inner surface and adjacent the pivoting edge; nor
- (4) coupling means located on a side edge for coupling the lid section to one or more additional lid sections, whereby the coupled lid sections form a *rigid, longitudinal modular lid* that can be opened and closed as a unit; nor
- (5) buoyancy tanks disposed within the modular lid sections for balancing gravitational and buoyancy forces.

Clearly, none of the above elements of the claimed invention are even suggested or anticipated in any way, let alone the combination of them in a single claim. **Applicant urges Examiner to consider the fact that NONE of the individual elements listed above are specifically, or by their equivalents, mentioned or suggested or referenced or taught in any manner in *Conterno*.** The failure of *Conterno* to suggest or anticipate even a single element is sufficient to withdraw the prior art as anticipating under 35 USC 102(e), but the absence of 5 or more specific elements simply cannot support a claim of anticipation under the current law.

Remark 3:

With regard to Applicant's currently amended claims, to establish a prima facie case of

obviousness under 35 U.S.C. § 103, the Examiner must show, either by objective teachings in the prior art or by knowledge generally available to a person of ordinary skill in the art, that such teachings or knowledge would lead such ordinary skilled person to combine relevant prior art teachings and/or knowledge, to account for limitations expressed in any particular claim, not described or alluded to in any prior art references, without making any unsupported assumptions. [See *In Re Beasley*, 04-1225 (Fed. Cir. 2004); *In re Dembiczak* (Fed. Cir. 1999) 175 F.3d 994, 999-1000, 50 U.S.P.Q.2d 1614; *In Re Fine* (Fed Cir. 1988) 837 F.2d 1071, 10 5 USPQ 2d 1596, 1598. [See also *Titanium Metals Corp. of America v. Banner*, (Fed. Cir. 1985) 778 F.2d 775, 780, 227 U.S.P.Q. 773]

To conclude, *Conterno* can not be properly cited as anticipating the limitations expressed in Applicant's Claims 4-5 under 35 U.S.C. § 102, especially as currently amended, without resorting to assumptions fueled by forbidden hindsight gained from the Applicant's invention as disclosed in his specification. The assumptions made by the Examiner to negate allowability of Applicant's prior claims could only be proper using the obviousness criteria of 35 U.S.C. § 103, and that rejection is not made herein.

In his telephonic interview on March 16, 2006, the Examiner has indicated that Claims 1 and 2 would be allowable if slight modifications were made thereto. Applicant has made the suggested amendments. Examiner has also indicated Claims 3 and 6 are allowable as amended.

In this Response, the Applicant currently amends Claims 4 and 5 to more clearly and precisely describe the limitations of his invented device.

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CONCLUSION

Conterno, the sole prior art reference relied upon by the Examiner to negative allowability of claims 4-5 of Applicant's application does ***not identically disclose or describe*** the limitations and elements of applicant's invention as recited in currently amended claims 4-5. Hence rejection of patentability of the currently amended claims and previously presented claims depending there from would not be lawful under 35 U.S.C. § 102 (a) or (e) in light of *Conterno*.

The Applicant respectfully submits that his currently amended claims also fully satisfy the obviousness criteria for patentability under 35 U.S.C. § 103 (a), particularly in light of the unsupported assumptions necessarily made by the Examiner in justifying prior rejections of Applicant claims 4-5 under 35 U.S.C. § 102 (a) or (e).

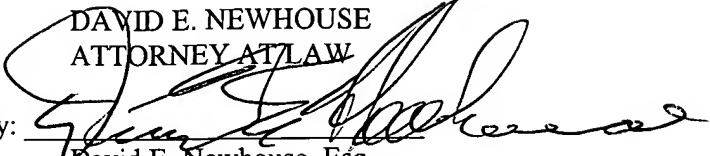
Yet, in the end, Applicant's claims, as currently amended, probably more clearly and precisely set forth patentable aspects of Applicant's modular lid system for underwater enclosures. [See M.P.E.P. § 2173.02]

Accordingly, a Notice of Allowability is respectfully, and urgently solicited.

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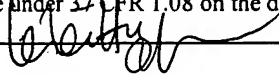
Respectfully submitted,

Dated: March 28, 2006

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CERTIFICATE OF MAILING

I hereby certify that this paper and the documents attached hereto are being deposited in a postage prepaid, sealed envelope with the United States Postal Service using First Class Mail service under 37 CFR 1.08 on the date indicated and is addressed to "Commissioner for Patents, Virginia 22313-1450". Signed: 
Date Mailed: March 28, 2006

REQUEST FOR CONTINUED EXAMINATION

Filing Date: January 14, 2004
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Title: **MODULAR LID AND ACTUATOR FOR UNDERWATER
POOL COVER DRUM ENCLOSURE**
Serial No.: 10/758,149
Attorney Docket No.: DEN-1693.20
RCE 032806-2.wpd